## REMARKS

Claims 1-18 remain in the application, with claims 11-18 standing as withdrawn. No claims are presently amended, added, or cancelled.

Claims 1-8 stand rejected under 35 USC §103(a) as being unpatentable over Franzreb (U.S. Pre-Grant Pub. No. 2006/0016732) in view of Kotlyar (U.S. Patent No. 6299174). Claims 9 and 10 have been indicated as allowable. Claims 11-18 stand withdrawn as directed to a non-elected invention that was subject to a Restriction Requirement. For the reasons as set forth below, the Applicants respectfully traverse the rejections on the basis that Franzreb is unavailable as a prior art reference against the instant application and that, therefore, the rejections under 35 USC §103(a) that rely on Franzreb must be withdrawn. The Applicants further submit that the instant claims are in condition for allowance, and respectfully request rejoinder of claims 11-18 on the basis that claims 11-18 each require the elements of either claim 1 or claim 2, both of which are in condition for allowance.

**Unavailability of Franzreb as a Prior Art Reference Against the Instant Application**

The Applicants respectfully submit that, for a reference to qualify as prior art to an application, the reference must satisfy the requirements of at least one of the following sections of 35 USC §102:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent,

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States,

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

To assess the prior art status of Franzreb relative to the instant application, it is necessary to establish the earliest priority date of the instant application. Because the date of invention must fall prior to the earliest priority date of the instant application, the Applicants respectfully submit that the earliest priority date effectively provides the latest date that could be considered the date of invention for purposes of assessing the prior art effect of references against the instant application.

Referring to the Filing Receipt for the instant application, which was mailed on October 24, 2006, the instant application is a §371 national-stage filing that claims priority to PCT/US04/18074, which was filed on June 8, 2004. PCT/US04/18074 claims the benefit of U.S. Provisional App. No. 60/476,978, which was filed on June 9, 2003. **As such, the instant application properly claims an earliest priority date of June 9, 2003, and this is the date that must be relied upon by the Examiner for purposes of properly qualifying references as prior art to the instant application.**

Turning to Franzreb, for purposes of 35 USC §102(a) and (b), this reference was first published on January 26, 2006. As such, **Franzreb is only prior art under 35 USC §102(a) to applications that were filed on or after January 26, 2006, and is only prior art under 35 USC §102(b) to applications that were filed on or after January 26, 2007.** Because the instant application has an earliest priority date of June 9, 2003, Franzreb is clearly not prior art against the instant application under either 35 USC §102(a) or (b).

For purposes of 35 U.S.C. §102(e), Franzreb is only prior art as of the earliest filing date thereof in the United States. Referring to the face of publication for Franzreb, the earliest filing date thereof in the United States is June 20, 2005, **which is well after the earliest priority date of the instant application of June 9, 2003.** In fact, the earliest priority date claimed by Franzreb is July 16, 2004, which is also well after the earliest priority date of the instant application. As such, the Applicants respectfully submit that Franzreb is not prior art to the instant application under 35 USC §102(e), and that none of

the foreign priority documents to which Franzreb claims priority could be prior art to the instant application.

In view of the foregoing, the Applicants respectfully submit that Franzreb does not qualify as prior art to the instant application, and that the rejections that rely on Franzreb must be withdrawn. Because there are no rejections of the instant claims other than those that rely on Franzreb, the Applicants respectfully submit that all of the current rejections have been overcome, and that the claims are in condition for allowance.

**Rejoinder of Dependent Claims 11-18**

The Applicants respectfully submit that in view of the allowability of claims 1-10, the Applicants are entitled to rejoinder of withdrawn claims 11-18. Referring to MPEP §821.04b:

> Where claims directed to a product and to a process of making and/or using the product are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or a process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 821 through § 821.03. However, if applicant elects a claim(s) directed to a product which is subsequently found allowable, withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must depend from or otherwise require all the limitations of an allowable product claim for that process invention to be rejoined. Upon rejoinder of claims directed to a previously nonelected process invention, the restriction requirement between the elected product and rejoined process(es) will be withdrawn.

As applied to the current claims, claims 1-10 each claim a vibrating magnetic separator (claims 9 and 10 are more particularly directed to a magnetic separator apparatus),

while dependent claims 11-18 each represent a process of using the separator that is claimed in either claim 1 or claim 2 (depending upon the particular claim). The instant circumstances are directly on point to the situation addressed by MPEP §821.04b. Specifically, claims 11-18 are each directed to a non-elected process invention that depends from or otherwise requires all the elements of an allowable product claim (i.e., either claim 1 or claim 2) such that the Applicants are entitled to rejoinder of the process invention claimed in claims 11-18, and Applicants respectfully request such rejoinder.

In view of the foregoing, the Applicants respectfully submit that claims 1-10 are in condition for allowance, and that the Applicants are entitled to rejoinder of withdrawn claims 11-18 such that claims 1-18 are in condition for allowance, which allowance is respectfully requested

This Response is timely filed such that it is believed that no fees are presently due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to our Deposit Account No. 08-2789.

Respectfully submitted,
**HOWARD & HOWARD ATTORNEYS, P.C.**

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